

REMARKS

This is a full and timely response to the outstanding Office Action mailed June 22, 2004. Upon entry of the amendments in this response claims 2-45 are pending. More specifically, claims 2, 26, 27, and 45 are amended and claim 46 is added. These amendments are specifically described hereinafter. It is believed that the foregoing amendments add no new matter to the present application.

I. Present Status of Patent Application

Claims 2-6, 22, 23, 27-30 and 32 are rejected under 35 U.S.C. 102(e) as being anticipated by Iwase *et al.* (US Patent No. 6,226,263). Claims 7, 8 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Iwase *et al.* in view of Chiu *et al.* (US Patent No. 6,597,689). Claims 9-18 and 34-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Iwase *et al.* in view of Chiu *et al.* and further in view of Waters *et al.* (U.S. Patent No. 5,832,069). Claims 19-21 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Iwase *et al.* in view of Dziedzic (U.S. Patent No. 6,166,895). Claims 24, 25, 43 and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Iwase *et al.* in view of Yokell (U.S. Patent No. 6,507,870). Claims 26 and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Iwase *et al.*, Chiu *et al.*, Waters *et al.*, Dziedzic and Yokell *et al.* as applied to claims 2-24 and 27-44 above respectively.

II. Examiner Interview

Applicants first wish to express their sincere appreciation for the time that Examiner Han spent with Applicants' Attorneys Jeff Kuester and Benjamin Balser during an August 18, 2004 telephone discussion regarding the above-identified Office Action. Applicants believe that issues regarding the composition of the network as claimed were identified during the telephone discussion, and that they are resolved herein. Applicants also notified Examiner Han of their intention to file an Affidavit under 37 C.F.R. §1.131 regarding the *Chiu*, *Dziedzic*, and *Yokell* references. During the conversation, Examiner Han seemed to indicate that it would be

potentially beneficial for Applicants to file this amendment and response. Thus, Applicants respectfully request that Examiner Han carefully consider these amendments and response.

III. Rejections Under 35 U.S.C. §102(e)

Claims 2-6, 22, 23, 27-30, and 32

The Office Action rejects independent claims 2 and 27 for similar reasons under 35 U.S.C. §102(e) as being anticipated by Iwase *et al.* (U.S. Patent No. 6,226,263). For the reasons set forth below, Applicants respectfully traverse the rejection.

Independent claim 2 recites:

2. A method for defining a path through an overall network for communications service between a unit and a service provider, comprising:
 - storing a topology of an overall network including elements and at least one link among the elements;
 - receiving a service order for provision of the communications service between the unit and the service provider; and
 - using information from the service order with the topology to select particular elements from the elements of the overall network and to select at least one particular link between the particular elements as the path for the communications service through the overall network,

wherein the overall network comprises at least a first type of network and a second type of network.

For a proper rejection of a claim under 35 U.S.C. §102, the cited reference must disclose, teach, or suggest all elements/features/steps of the claim at issue. *See, e.g., E.I. du Pont de Nemours & Co. v. Phillips Petroleum Co.*, 849 F.2d 1430, 7 U.S.P.Q.2d 1129 (Fed. Cir. 1988).

Applicants respectfully submit that independent claims 2 and 27 as amended are allowable for at least the reason that *Iwase* does not disclose, teach, or suggest at least an overall

network, **wherein the overall network comprises at least a first type of network and a second type of network.** *Iwase* only discloses one type of network, an ATM network, and working within that ATM network. In the instant claims, multiple types of networks are included in the path. Linking between more than one type of network element (e.g. ATM, DSL and a CO) is not disclosed in *Iwase*.

Notwithstanding, no such teaching can be identified anywhere within this reference. Therefore, *Iwase* does not anticipate claims 2 and 27 and the rejection should be withdrawn.

Because independent claims 2 and 27 as amended are allowable over the prior art of record, dependent claims 3-6, 22, 23, 28-30 and 32 (which depend from independent claims 2 and 27) are allowable as a matter of law for at least the reason that the dependent claims contain all the steps/features of independent claims 2 and 27 respectfully. *See Minnesota Mining and Manufacturing Co. v. Chemque, Inc.*, 303 F.3d 1294, 1299 (Fed. Cir. 2002) *Jeneric/Pentron, Inc. v. Dillon Co.*, 205 F.3d 1377, 54 U.S.P.Q.2d 1086 (Fed. Cir. 2000); *Wahpeton Canvas Co. v. Frontier Inc.*, 870 F.2d 1546, 10 U.S.P.Q.2d 1201 (Fed. Cir. 1989). Therefore, since the dependent claims are patentable over *Iwase*, the rejection to the dependent claims should be withdrawn and the claims allowed.

Additionally and notwithstanding the foregoing reasons for allowability of independent claims 2 and 27 dependent claims 3-6, 22, 23, 28-30 and 32 recite further features and/or combinations of features, as are apparent by examination of the claims themselves, that are patently distinct from the prior art of record. Hence there are other reasons why the dependent claims are allowable.

IV. Rejections Under 35 U.S.C. §103(a)

A. Claims 7, 8, and 33

The Office Action rejects claims 7, 8, and 33 under 35 U.S.C. §103(a) as being unpatentable over *Iwase et al.* in view of *Chiu et al.* For the reasons set forth below, Applicants respectfully traverse the rejection.

Applicants have submitted an Affidavit pursuant to 37 C.F.R. §1.131 declaring that Applicants achieved an actual reduction to practice prior to the effective filing date of the *Chiu* reference. As claims 7, 8, and 33 have been rejected in view of *Chiu*, Applicants respectfully submit that claims 7, 8, and 33 are allowable as a matter of law.

Additionally and notwithstanding the foregoing reasons for the allowability of claims 7, 8, and 33, claims 7, 8, and 33 recite features and/or combinations of features, as are apparent by examination of the claims themselves, that are patently distinct from the prior art of record. Hence, there are other reasons why claims 7, 8, and 33 are allowable.

B. Claims 9-18 and 34-42

The Office Action rejects claims 9-18 and 34-42 under 35 U.S.C. §103(a) as being unpatentable over *Iwase* in view of *Chiu* and *Waters*. For the reasons set forth below, Applicants respectfully traverse the rejection.

Applicants have submitted an Affidavit pursuant to 37 C.F.R. §1.131 declaring that Applicants achieved an actual reduction to practice prior to the effective filing date of the *Chiu* reference. As claims 9-18 and 34-42 have been rejected in view of *Chiu*, Applicants respectfully submit that claims 9-18 and 34-42 are allowable as a matter of law.

Additionally and notwithstanding the foregoing reasons for the allowability of claims 9-18 and 34-42, claims 9-18 and 34-42 recite features and/or combinations of features, as are apparent by examination of the claims themselves, that are patently distinct from the prior art of record. Hence, there are other reasons why claims 9-18 and 34-42 are allowable.

C. Claims 19-21 and 31

The Office Action rejects claims 19-21 and 31 under 35 U.S.C. §103(a) as being unpatentable over *Iwase* in view of *Dziedzic*. For the reasons set forth below, Applicants respectfully traverses the rejection.

Applicants have submitted an Affidavit pursuant to 37 C.F.R. §1.131 declaring that Applicants achieved an actual reduction to practice prior to the effective filing date of the *Dziedzic*

reference. As claims 19-21 and 31 have been rejected in view of *Dziedzic*, Applicants respectfully submit that claims 19-21 and 31 are allowable as a matter of law.

Additionally and notwithstanding the foregoing reasons for the allowability of claims 19-21 and 31, claims 19-21 and 31 recite features and/or combinations of features, as are apparent by examination of the claims themselves, that are patently distinct from the prior art of record. Hence, there are other reasons why claims 19-21 and 31 are allowable.

D. Claims 24, 25, 43 and 44

The Office Action rejects claims 24, 25, 43 and 44 under 35 U.S.C. §103(a) as being unpatentable over *Iwase* in view of *Yokell*. For the reasons set forth below, Applicants respectfully traverse the rejection.

Applicants have submitted an Affidavit pursuant to 37 C.F.R. §1.131 declaring that Applicants achieved an actual reduction to practice prior to the effective filing date of the *Yokell* reference. As claims 24, 25, 43 and 44 have been rejected in view of *Yokell*, Applicants respectfully submit that claims 24, 25, 43 and 44 are allowable as a matter of law.

Additionally and notwithstanding the foregoing reasons for the allowability of claims 24, 25, 43 and 44, claims 24, 25, 43 and 44 recite features and/or combinations of features, as are apparent by examination of the claims themselves, that are patently distinct from the prior art of record. Hence, there are other reasons why claims 24, 25, 43 and 44 are allowable.

E. Claims 26 and 45

The Office Action rejects claims 26 and 45 under 35 U.S.C. §103(a) as being unpatentable over *Iwase* in view of *Chiu*, *Waters*, *Dziedzic*, and *Yokell*. For the reasons set forth below, Applicants respectfully traverse the rejection.

Applicants have submitted an Affidavit pursuant to 37 C.F.R. §1.131 declaring that Applicants achieved an actual reduction to practice prior to the effective filing date of the *Chiu*, *Dziedzic*, and *Yokell* references. As claims 26 and 45 have been rejected in view of *Chiu*, *Dziedzic*, and *Yokell*, Applicants respectfully submit that claims 26 and 45 are allowable as a matter of law.

Additionally and notwithstanding the foregoing reasons for the allowability of claims 26 and 45, claims 26 and 45 recite features and/or combinations of features, as are apparent by examination of the claims themselves, that are patently distinct from the prior art of record. Hence, there are other reasons why claims 26 and 45 are allowable.

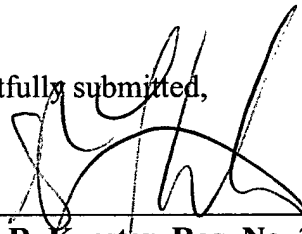
V. Prior References Made of Record

The prior references made of record have been considered, but are not believed to affect the patentability of the presently pending claims. Other statements not explicitly addressed herein are not admitted.

CONCLUSION

In light of the foregoing amendments and for at least the reasons set forth above, Applicant respectfully submits that all objections and/or rejections have been traversed, rendered moot, and/or accommodated, and that the now pending claims 2-45 are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned agent at (770) 933-9500.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Jeffrey R. Kuester', is written over a horizontal line.

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